

REMARKS

Claims 1-24 were pending in the application. Claims 1-4, 6-12, and 14-16 have been amended. Support for the amendment to claim 1 may be found, e.g., on page 6, lines 9-15 of the present application. Claims 13 and 17-24 have been canceled, and new claims 25-30 have been added. Support for new independent claims 25-28 may be found, respectively, on page 4, lines 14-20, page 7, lines 14-19, page 6, lines 1-4, and page 5, lines 26-27. Therefore, claims 1-12, 14-16, and 25-30 are now pending in the present application. Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Priority

The Examiner is thanked for acknowledging receipt of the priority documents.

Allowable Subject Matter

The Examiner is sincerely thanked for indicating that claims 4 and 15 contain allowable subject matter. Claims 4 and 15 have been written in independent form, with additional amendments to improve clarity and to place the claims in more typical U.S. format.

Drawing Objections

Fig. 3 is objected to because of the use of reference number "5". Unlike the prior art embodiments in Figs. 1 and 2 in which prisms 2, 2', and 3 are connected to the basic body portion 1 (instead of microscope accessories 4, 4', 5), the embodiment in Fig. 3 shows prisms 2' and 3 connected to microscope accessories 108, 107 via coupling portions 4a, 5a, respectively. Therefore, the reference number "5" in Fig. 3 has been amended as "5a." Withdrawal of the objection is respectfully requested.

Figs. 1 and 2 are objected to for failing to designate the legend, "Prior Art." The drawings have been amended where appropriate. Withdrawal of the objections is respectfully requested.

The drawings are objected to for failing to show: 1) the objective and eyepiece as recited in claims 1 and 12; 2) reflection of a portion of light to the eyepiece as recited in

claims 1 and 12; 3) various microscope accessories as recited in claims 3 and 14; 4) a plane parallel plate as recited in claims 6 and 18; 5) further optical components as recited in claims 9 and 21; and 6) the coding as recited in claims 10 and 23.

New Figs. 4 and 5 have been added. Applicant respectfully asserts that no new matter has been added because new Figs. 4 and 5 are based on the structural descriptions as set forth in the specification as originally filed.

Regarding 1), objective 102 and eyepieces 103, 104 are shown in new Figs. 4 and 5. Regarding 2), “to the eyepiece” has been canceled from claims 1 and 12. Regarding 3), microscope accessories 107, 108, 111 are now shown in Fig. 3 and new Figs. 4 and 5. Regarding 4), plane parallel plate 110 is shown in new Fig. 5. Regarding 5), optical component 113 is shown in new Fig. 4. Regarding 6), “a coding” has been canceled from claim 10, and claim 23 has been canceled. Therefore, withdrawal of the objections is respectfully requested.

Specification Objections

The specification is objected to because the Summary of the Invention is too long. A substantial portion of the disclosure in the Summary of the Invention has been moved to the Detailed Description of the Invention, as in the attached Substitute Specification. The Substitute Specification contains no new matter, and a Redline version showing changes made is also attached. Withdrawal of the objection is respectfully requested.

The specification is also objected to because of various informalities. Instead of amending the specification to change “3” to “3’,” as suggested, Fig. 3 of the drawings has been amended to change “3” to “3” to preserve consistency and clarity in the application. Withdrawal of the objection is respectfully requested.

35 U.S.C. §112 Rejections

Claim 16 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Claims 12, 14, and 16 have been amended to improve consistency of the structural relationships among the claimed elements. Withdrawal of the rejection is respectfully requested.

Claims 1-24 are rejected under 35 U.S.C. §112, second paragraph, for indefiniteness. The claims have been amended where appropriate, and Applicant believes that all §112 issues have been addressed and rectified. Withdrawal of the rejections is respectfully requested.

Double Patenting Rejections Under 35 U.S.C. §101

Claims 19 and 20 are rejected under 35 U.S.C. §101 for being substantial duplicates of claims 7 and 8, respectively. Claims 19 and 20 have been canceled, thus mooting the rejections.

Prior Art Rejections

Claims 1-3, 7-11, and 19-20 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,219,180 to Hasegawa et al. (hereinafter “Hasegawa”). Claims 5, 12-14, 17, and 21-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,303,082 to Obuchi et al. (hereinafter “Obuchi”) in view of Hasegawa. Applicant respectfully traverses these rejections for at least the following reasons.

Amended claim 1 recites that the beam splitter is configured to allow a choice between reflecting a portion of light out of the beam path and reflecting images into the beam path going to the at least one eyepiece. Hasegawa discloses an optical switching apparatus having filter cassettes 19a – 19d, each filter cassette having an excitation filter 17, a dichroic mirror 12, and a barrier filter 11. (Col. 1, lines 11-33 and col. 4, lines 30-42.) As shown in Fig. 1, light from source 18 passes through filter 17, reflects off mirror 12, reflects off sample 15, and passes through mirror 12 and filter 11. Quite simply, Hasegawa does not teach, disclose, or suggest allowing a choice between reflecting a portion of light out of the beam path and reflecting images into the beam path going to the eyepiece. Obuchi fails to cure the deficiencies of Hasegawa. Therefore, claim 1, and all claims dependent therefrom, are believed to be patentable over the cited references. Withdrawal of the rejections is respectfully requested.

New Claims

New claim 25 recites at least one intensity beam splitter. An example of an intensity beam splitter, such as one whose splitting ratio differs from 50/50, is offered on page 4, lines

14-20 of the present application. Hasegawa discloses only a dichroic mirror 12, which “reflects light of a short wavelength and [passes] light of a long wavelength.” (Col. 1, lines 20-23.) Hasegawa does not teach, disclose, or suggest an intensity beam splitter.

New claim 26 discloses that the beam splitter is configured to at least one of reflect a portion of an image out of the beam path and reflect an image into the beam path going to the at least one eyepiece, and new claim 27 recites that the beam splitter is configured to reflect an image into the beam path going to the at least one eyepiece. In Hasegawa, the dichroic mirror 12 serves only to reflect short wavelength light (not an image) to excite sample 15. Hasegawa does not teach, disclose, or suggest a beam splitter that is configured to at least one of reflect a portion of an image out of the beam path and reflect an image into the beam path going to the at least one eyepiece.

New claim 28 recites that the beam splitter is configured to reflect a portion of an image out of the beam path for at least one of detection by a light detector and observation by an observer. Hasegawa does not disclose that dichroic mirror 12 reflects a portion of an image out of the beam path 13, particularly for detection by a light detector or observation by an observer.

Obuchi fails to cure the deficiencies of Hasegawa. Therefore, new independent claims 25-28, and all claims dependent therefrom, are believed to be patentable over the cited references.

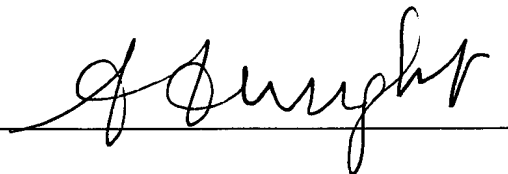
Conclusion

Applicant believes that the present application is in condition for allowance, and favorable reconsideration is requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date MAR 05 2004

By 

FOLEY & LARDNER
Customer Number: 22428



22428

PATENT TRADEMARK OFFICE

Telephone: (202) 945-6136

Facsimile: (202) 672-5399

Andrew F. Knight
Agent for Applicant
Registration No. 50,443

Should additional fees be necessary in connection with the filing of this paper, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees.